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10/597,277	07/19/2006	Fabio Vignoli	US040043US2	8768

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EXAMINER	
ZHAO, YU	
ART UNIT	**PAPER NUMBER**
2169	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/597,277	VIGNOLI ET AL.	
	Examiner	Art Unit	
	YU ZHAO	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 June 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *19 July 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. **Claims 1-21** are presented for examination.

2. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. The Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed. Priority date of **January 17, 2005** is given.

4. It is acknowledged that the pending application claims priority to provisional application **60/537802** filed on **January 20, 2004**. Priority date of **January 20, 2004** is given.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on **July 19, 2006** is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:
(1) if a machine or apparatus, its organization and operation;
(2) if an article, its method of making;
(3) if a chemical compound, its identity and use;
(4) if a mixture, its ingredients;
(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

6. The abstract of the disclosure is objected to because it is not compliant with U.S. format. Correction is required. See MPEP § 608.01(b).

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 2, “time-independent user preferences” has not been defined in the specification.

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 3, “event-independent” has not been defined in the specification.

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: In claims 6 and 10, “based on a third set”, “a third subset” and "identified in the third subset" have not been defined in the specification.

10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 7, “searching the source of material based on a frequency of access of the items”, the terminology “frequency” has not been disclosed in the specification.

Claim Objections

11. **Claim 1** is objected to because of the following informalities: Claim 1 recites "a second selector that is configured to …provide thereform a second subset…within the source of material that facilitates subsequent rendering…” The above claimed limitations are confusing and not clear and leave the examiner in doubt as to the features to which they refer (i.e. what facilitates rendering: the “selector”? the “second subset”? or maybe “the source of material”?).

12. **Claim 2** is objected to because of the following informalities: Claim 2 recites “time-independent user preferences” However, the term has not been defined in the specification. Appropriate correction is required.

13. **Claim 3** is objected to because of the following informalities: Claim 3 recites “event-independent” However, the term has not been defined in the specification. Appropriate correction is required.

14. **Claim 4** is objected to because of the following informalities: Claim 4 recites the terms "general user preferences” and “specific user preference” The above claimed

limitations are vague and unclear, thus leaving the reader in doubt as to the meaning of the technical features to which they refer. Appropriate correction is required.

15. **Claims 6 and 10** are objected to because of the following informalities: Claims 6 and 10 recite “based on a third set”, “a third subset” and "identified in the third subset". However, examiner is unable to find support for the above limitation in the Specification. Appropriate correction is required.

16. **Claim 7** is objected to because of the following informalities: Claim 7 recites “searching the source of material based on a frequency of access of the items.” However, the terminology “frequency” has not been used in the Specification. Appropriate correction is required.

17. **Claim 18** is objected to because of the following informalities: Claim 18 recites the term “substantially time-invariant user preferences” The above claimed limitation is vague and unclear, thus leavings the reader in doubt as to the meaning of the technical features to which they refer. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> a. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

18. **Claims 1-21 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.**

As to **claims 1-10**, "A play list generator…" claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claims 11-16 recite "a system", the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

As to **claims 17-21**, "A method of generating a playlist…" claimed as method claims that recited purely mental steps. The claim lacks the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. As such, they fail to tie with a statutory category. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in

anticipation of applicant amending these claims to place them within the four categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. **Claims 1-5, 11-13, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoch (U.S. Pub. No.: US 2003/0191753 A1).**

For claim 1, Hoch discloses a playlist generator comprising:

a first selector that is configured to search a source of material and to provide therefrom a first subset of identifications of items within the source of material, based on a first set of user preferences (Hoch: page 1, paragraph [0006], "When a request to search for a content in a community is received, a search is performed for the content at one or more nodes of the community.", page 4, paragraph [0046], "list of contents, such as music or movies, may be collected from one or more peers within a community through a multilevel hierarchical searching method based on a user's persona information using a learning mechanism.", page 5, paragraph [0058], "when a user initiates a search, a

set of parameters 301 may be used to specify how the search is being conducted…"), **and**

a second selector that is configured to search the first subset of identifications based on a second set of user preferences, and to provide therefrom a second subset of identifications of items within the source of material that facilitates subsequent rendering of the items identified in the second subset (Hoch: page 4, paragraph [0046], "The contents searched and received from the one or more peers may be filtered using multiple levels of details and a learning algorithm…based on a user's persona information.", where "levels" indicates numbers of filtering processes, page 5, paragraph [0061], "When a user selects an area from a search result displayed…the search conducts a search and filters the information collected from the peers based on persona information of the user, as well as the user's past preferences or behaviors…", paragraph [0062], "…when a user selects an area from the display of the level shown in FIG. 3B, the search may display further detailed information from the search result, such as information 310 regarding to specific artists of the songs derived from those genres or sub-genres", Fig. 3A-3D).

For claim 2, Hoch discloses the playlist generator of claim 1, wherein the first set of user preferences includes time-independent user preferences (Hoch: page 4, paragraph [0046]-[0057], "Interests…Artist

lists…Mood of a song…", where "time-independent" is read on "artist list", page 5, paragraph [0058], "FIG. 3A, when a user initiates a search, a set of parameters 301 may be used to specify how the search is being conducted."), **and**

the second set of user preferences includes user preferences at a particular time (Hoch: pages 3-4, paragraph [0040], pages 4-5, paragraph [0046]-[0058], "interest…Favorite songs…Favorite artists…Rating of a user…Mood of a song…Words of the song (e.g., lyrics) The above set of information may be used as parameters, when a user conducts a search, to match people or match a song profile with a person.", where "user preferences at a particular time" is read on "mood of a song").

For claim 3, Hoch discloses the playlist generator of claim 1, wherein

the first set of user preferences includes event-independent user preferences (Hoch: page 4, paragraph [0046]-[0057], page 5, paragraph [0058]), **and**

the second set of user preferences includes user preferences upon an occurrence of an event (Hoch: pages 3-4, paragraph [0040], pages 4-5, paragraph [0046]-[0058], where "occurrence or an event" is read on "Mood of a song", (i.e. event-specific, when during an love/romantic event, the user would like to play love or romantic songs)).

Claim 4 is rejected as substantially similar as claim 2, for the similar reasons.

For claim 5, Hoch discloses the playlist generator of claim 1, wherein

the source of material includes one or more internet web-sites (Hoch: page 2, paragraph [0029]-[0030]).

Claim 11 is rejected as substantially similar as claim 1, for the similar reasons.

Claim 12 is rejected as substantially similar as claim 2, for the similar reasons.

Claim 13 is rejected as substantially similar as claim 5, for the similar reasons.

Claim 17 is rejected as substantially similar as claim 1, for the similar reasons.

Claim 18 is rejected as substantially similar as claim 2, for the similar reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. **Claims 6, 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoch (U.S. Pub. No.: US 2003/0191753 A1) as applied to claims 1, 11 and 17 above, in view of Salam et al. (U.S. Patent No.: U.S. 6,594,654 B1, hereinafter, Salam).**

For claim 6, Hoch discloses the playlist generator of claim 1, further including non-volatile memory that is configured to store the first subset of identifications, and the second selector is further configured to search the first subset of identifications, based On a third set of user preferences, to provide therefrom a third subset of identifications of items within the source of material,

to form another playlist that facilitates subsequent rendering of the items identified in the third subset (Hoch: page 5, paragraph [0058]-[0062]).

However, Hoch does not explicitly disclose store the first subset.

Salam discloses store the first subset (Salam: column 10, lines 52-56, " a first set of raw search results 50a are stored...The first set of search results 50a which includes listings 1-7 are processed to obtain a second set of results 50b.").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon "Filtering contents using a learning mechanism" as taught by Hoch by implementing "Systems and methods for continuously accumulating research information via a computer network" as taught by Salam, because it would provide Hoch's generator with the enhanced capability of ""filtering" the information by categorizing the cards as a function of quality or state of currency or completeness, etc., (6) selecting and retaining those items of information that satisfy the researcher's goals" (Salam: column 2, lines 55-59).

Claim 14 is rejected as substantially similar as claim 6, for the similar reasons.

Claim 21 is rejected as substantially similar as claim 6, for the similar reasons.

21. **Claims 7-9, 15, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoch (U.S. Pub. No.: US 2003/0191753 A1) as applied to claims**

1, 11 and 17 above, in view of Breese et al. (U.S. Patent No.: U.S. 6,006,218, hereinafter, Breese).

For claim 7, Hoch discloses the playlist generator of claim 1, wherein

the first set of user preferences includes one or more parameters for searching the source of material based on a frequency of access of the items within the source of material (Hoch: page 4, paragraph [0040], "persona information for a user of a device may include a set of attributes such as, an artist list, a song list, a favorite song list, a favorite artist list, rating of users,", paragraph [0041], "persona information associated with a user of a device is automatically collected. For example, a list of interests of a user of the device 5 may be automatically generated by recording the web sites the user visits, the music the user listens to, the films the user watches, etc."), **and**

the first selector is configured to determine a measure of requests for each item within the source material by a plurality of users, and to provide therefrom the first subset of identifications of items, based on the measure of requests for each item (Hoch: page 2, paragraph [0027], page 7, paragraph [0080], where "measure of request for each item" is read on "popular").

However, Hoch does not explicitly disclose based on a frequency of access of the items, and

measure of requests for each item within the source material by a plurality of users.

Breese discloses based on a frequency of access of the items (Breese: column 8, lines 16-24, "In step 222 input relating to, e.g., the search to be performed, user attributes, user preferences and/or the user's existing knowledge about items included in the information database to be searched, is obtained…may provide information on which sites a user likes based on a user's frequent access of certain sites…"), **and**

measure of requests for each item within the source material by a plurality of users (Breese: column 2, lines 53-55, "In order to generate the knowledge probability estimates, factors which may be considered include: the popularity of the individual data items being searched…" Column 2, line 65-column3, line 7, "Collaborative filters generate, using historical information on a large number of individuals preferences and information on the attributes and preferences of a particular user, a list of recommendations sorted by their estimated value to the user. The historical information relating to an item's popularity used to perform a collaborative filtering operation may also be used to generate knowledge probability estimates in accordance with the present invention. For this reason, collaborative filters are

particularly well suited for use with the present invention.", where "measure of requests" is read on "popularity").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon "Filtering contents using a learning mechanism" as taught by Hoch by implementing "Methods and apparatus for retrieving and/or processing retrieved information as a function of a user's estimated knowledge" as taught by Breese, because it would provide Hoch's generator with the enhanced capability of "an improved method of making recommendations or suggestions to the user regarding other Internet sites or data items which might be unknown but interesting to the user." (Breese: column 3, lines 8-31).

Claim 8 is rejected as substantially similar as claim 4, for the similar reasons.

Claim 9 is rejected as substantially similar as claim 3, for the similar reasons.

Claim 15 is rejected as substantially similar as claim 7, for the similar reasons.

Claim 16 is rejected as substantially similar as claim 8, for the similar reasons.

Claim 19 is rejected as substantially similar as claim 7, for the similar reasons.

Claim 20 is rejected as substantially similar as claim 2, for the similar reasons.

22. **Claims 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoch (U.S. Pub. No.: US 2003/0191753 A1), in view of Breese et al. (U.S. Patent No.: U.S. 6,006,218, hereinafter, Breese) as applied to claim 7 above, and further in view of Salam et al. (U.S. Patent No.: U.S. 6,594,654 B1, hereinafter, Salam).**

Claim 10 is rejected as substantially similar as claim 6, for the similar reasons.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YU ZHAO whose telephone number is (571)270-3427. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571) 272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-270-4427.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 10/17/2008

/Yu Zhao/

Examiner, Art Unit 2169

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/Y. W./

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